

REMARKS

Claims 1-53 are pending in this application. Claims 24-32 and 53 are withdrawn from consideration. Claims 1, 15, 21, 23-24, 33, 47, and 53 are independent. In light of the remarks contained herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1-23 and 33-52 under 35 U.S.C. § 103(a) as being unpatentable over *Tanaka et al.* (USP 5,582,103) in view of *Tsakanikas* (USP 5,570,465). Applicant respectfully traverses this rejection. In support of the Examiner's rejection of claim 1, the Examiner asserts that *Tanaka et al.* discloses creating a valuable document in response to the order by associating with the valuable document a subset of a position coding pattern, citing to the Abstract, Figs. 1-3, and their associated description. Applicant respectfully disagrees with the Examiner's characterization of this reference.

The disclosure of *Tanaka et al.* is directed to a method for making an anti-counterfeit latent image formation object for bills, credit cards, etc. The anti-counterfeit latent image formation object includes a main body, a plurality of projections and/or recesses formed on the main body in such a manner as to exhibit various kinds of patterns, in which the various kinds of patterns include straight image lines forming a pattern, a relief pattern,

or a combination of the pattern and the relief pattern. The object further includes a plurality of straight lines printed on at least one surface of the main body at predetermined intervals, the straight lines being printed in a different color from that of the main body itself. The patterns consisting of letters, figures, etc., can be visually recognized only when the anti-counterfeit latent image formation object is viewed from an adequate angle (Abstract).

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, a method for managing valuable documents comprising creating a valuable document by **associating with the valuable document a subset of a position coding pattern.**

As noted above, *Tanaka et al.* merely provides for a plurality of projections and/or recesses on the main body to exhibit various kinds of patterns which may be visually recognized. There is no teaching or suggestion in *Tanaka et al.* that is directed to a position coding pattern. Further, there is no teaching or suggestion in *Tanaka et al.* that discloses associating with the valuable document a subset of a position coding pattern.

Tsakanikas fails to cure the deficiencies of the teachings of *Tanaka et al.* as *Tsakanikas* further fails to teach or suggest a position coding pattern. Further, *Tsakanikas* fails to teach or suggest associating with the valuable document a subset of a position coding pattern. As neither of the references, either alone

or in combination, assuming these references are combinable, which Applicant does not admit, teach or suggest all of the claim elements, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-14 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

With regard to the Examiner's rejection of claim 15, curiously, the Examiner now admits that *Tanaka et al.* fails to teach or suggest at least one pair of coordinates that has been recorded by reading a position coding pattern on a valuable document. The Examiner now relies on the teachings of *Tsakanikas* to cure the deficiencies of the teachings of *Tanaka et al.*, asserting *Tsakanikas* teaches at least one pair of coordinates that has been recorded by reading a position coding pattern on a valuable document, citing to the Abstract and Figs. 1-5, together with the associated disclosure. Applicant respectfully disagrees with the Examiner's characterization of these references.

The disclosure of *Tsakanikas* is directed to an apparatus, method, and system for printing legal currency and negotiable instruments. Fig. 1 discloses a functional block diagram of the

apparatus and interconnection of the invention, while Fig. 5 discloses a network diagram. Neither of these references teach or suggest a position coding pattern that is read to discern at least one pair of coordinates. Again, as neither of the references teach or suggest all of the claim elements, either alone or in combination, assuming these references are combinable, which Applicant does not admit, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

Should the Examiner maintain his rejection of any of these claims, it is respectfully requested that the Examiner clearly identify to the Applicant, in a non-Final Official Action, those portions of the references the Examiner is relying upon to teach or suggest the position coding pattern and the reading of the position coding pattern to identify the at least one pair of coordinates.

It is respectfully submitted that claims 16-20 are allowable for the reasons set forth above with regard to claim 15 at least based upon their dependency on claim 15.

It is respectfully submitted that claims 21 and 33 include elements similar to those discussed above with regard to claim 1, and thus these claims, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1. It is further respectfully submitted that claim 47 includes

elements similar to those discussed above with regard to claim 15, and thus claim 47, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 15.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Michael K. Mutter, #29,680


MKM/CMV/jdm
3782-0110P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000